



JPW

SHI.042

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Satoshi Hoshino

Serial No.: 09/895,173

Group Art Unit: 2621

Filed: July 2, 2001

Examiner: Shefali Patel

For: ELECTRONIC JOURNAL PREPARATION SYSTEM AND ELECTRONIC
JOURNAL PREPARATION METHOD

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

RESPONSE TO DECISION ON PETITION

Sir:

Applicant gratefully acknowledges the indication, in the Decision on Petition dated November 29, 2005, that Applicant's petition filed on November 10, 2005 and November 17, 2005 has been granted and that the RCE filed on October 13, 2005 has been entered.

Applicant submits this paper, however, to clarify statements included in the Decision on Petition. That is, in the Decision on Petition, the Special Programs Examiner stated that "[g]iven that Applicant's response of August 8, 2005 was considered by the examiner, but did not place the application in condition for allowance, this response was entered and thus in accordance with MPEP §706.07(h)(III)(D), would not constitute a proper submission" (see Decision on Petition dated November 29, 2005 at page 2).

Applicant, however, respectfully disagrees.

That is, the Special Programs Examiner has applied an erroneous section of the M.P.E.P. in his reasoning. Applicant submits that MPEP §706.07(h)(II) (not section

SHI.042

Serial No. 09/895,173

(III)(D) as alleged by the Special Programs Examiner) defines what constitutes a submission for purposes of a proper RCE. Indeed, the M.P.E.P. clearly states that “a previously filed amendment after final (**whether or not entered**) may satisfy this submission requirement. Arguments filed after final rejection, which were entered by the examiner but not found persuasive, may satisfy the submission requirement if such arguments are responsive within the meaning of 37 C.F.R. 1.111 to the Office Action” (see MPEP §706.07(h)(II)) (emphasis added by Applicant).

Therefore, even though the Response filed on August 8, 2005 was considered by the Examiner, the Response constitutes a proper submission because the Response filed on August 8, 2005 was fully responsive within the meaning of 37 C.F.R. 1.111. The Special Programs Examiner’s allegation that since the response “was entered and thus in accordance with MPEP §706.07(h)(III)(D), would not constitute a proper submission” is clearly incorrect in accordance with MPEP §706.07(h)(II)).

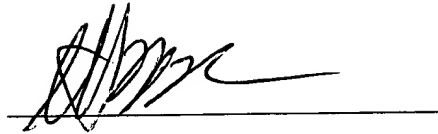
SHI.042

Serial No. 09/895,173

Applicant appreciates the consideration of the above remarks.

Respectfully Submitted,

Date: December 5, 2005

A handwritten signature in black ink, appearing to read 'Scott M. Tulino', is written over a horizontal line.

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